

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:
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PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

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| Applicant's or agent's file reference 2003/01 PCT | | Date of mailing (day/month/year) 10 FEB 2005 FOR FURTHER ACTION See paragraph 2 below |
| International application No. PCT/US04/15082 | International filing date (day/month/year) 13 May 2004 (13.05.2004) | Priority date (day/month/year) 15 May 2003 (15.05.2003) |
| International Patent Classification (IPC) or both national classification and IPC IPC(7): C 07 C 69/00 and US Cl.: 560/139 | | |
| Applicant INVISTA TECHNOLOGIES SA RL | | |

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

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| Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230 | Authorized officer <i>[Signature]</i> Ms. Cecilia Tsang Telephone No. 571-272-0562 |
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WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US04/15082

Box No. 1 Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

- ☐ a sequence listing
☐ table(s) related to the sequence listing

b. format of material

- ☐ in written format
☐ in computer readable form

c. time of filing/furnishing

- ☐ contained in international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE
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International application No.

PCT/US04/15082

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application
☒ claims Nos. 4,6,7,9-11 and 21-25

because:

- ☐ the said international application, or the said claim Nos. _____ relate to the following subject matter which does not require an international preliminary examination (*specify*):

- ☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 4,6,7,9-11 and 21-25 are so unclear that no meaningful opinion could be formed (*specify*):

Claims 4, 6, 7, 9, 10, 11, 21-25 are confusing since it is not clear what is even the possible invention being claimed.

Claims 4, 6 and 7 depend on claim 1, which is drawn to an ester. However, the said claims contain limitations directed to further limit a composition. Thus, it is unclear if the invention is a composition or a compound. Since the independent claim is drawn to a compound, it is unclear what is the composition that is being limited in the said claims, thus the said composition-claims are unsearchable.

Claims 9, 10 and 11, depend on an independent claim 8, which is drawn to a method of preparation. Nonetheless, claims 9, 10 and 11 are drawn to limit a product. Thus it is unclear if the invention is a compound or a method of preparation. Therefore claims 9, 10 and 11 are unclear and unsearchable.

Claims 21-25 are directed to a composition nonetheless it is unclear what are the components of the said composition. For instance the term "catalyst" embraces multiple possibilities and it is unclear what can satisfy the limitations of the said composition. Since the components of the said composition are not clearly defined the said composition is unsearchable.

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International application No.

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Box No. IV Lack of unity of invention

1. ☐ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has:
- ☐ paid additional fees
 - ☐ paid additional fees under protest
 - ☐ not paid additional fees
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
- ☐ complied with
 - ☐ not complied with for the following reasons:

4. Consequently, this opinion has been established in respect of the following parts of the international application:

- ☐ all parts.
- ☐ the parts relating to claims Nos. _____

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/US04/15082

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted: